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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/695,273

10/27/2003

Paul Shieh

2667-04

5329

7590

02/18/2009

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EXAMINER

JUNG, UNSU

ART UNIT

PAPER NUMBER

1641

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/695,273	<b>Applicant(s)</b> SHIEH ET AL.	
	<b>Examiner</b> UNSU JUNG	<b>Art Unit</b> 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

1. Claims 1-52 are pending.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-26, drawn to an amperometric sensor for determination of glucose, classified in class 422, subclass 82.01, for example.
  - II. Claims 27-52, drawn to a method for assaying a sample for determination of the concentration of glucose, classified in class 435, subclass 7.9, for example.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product as claimed can be used in a materially different process. For example, the amperometric sensor of Group I can be used for detection of analytes other than glucose (e.g. immunoassay using glucose oxidase as an enzyme label).

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4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election

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shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### ***Election of Species within Group I***

5. This application contains claims directed to the following patentably distinct species:

#### **List I: Electrically Conductive Tracks (claims 4 and 17)**

1. Metallic silver (claims 4 and 17)
2. Silver salts (claims 4 and 17)
3. Mixtures of metallic silver and silver salts (claims 4 and 17)
4. Conductive graphite (claims 4 and 17)
5. Carbon (claims 4 and 17)
6. Copper (claims 4 and 17)
7. Platinum (claims 4 and 17)
8. Cobalt (claims 4 and 17)
9. Nickel (claims 4 and 17)

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10. Gold (claims 4 and 17)
11. Electrically conductive polymers (claims 4 and 17)

List II: Redox Mediator (claims 5 and 18)

1. Ferrocyanide salts ( $\text{Fe}(\text{CN})_6^{4-}$ ) (claims 5 and 18)
2. HCN (claims 5 and 18)
3.  $\text{I}^-$  (claims 5 and 18)
4.  $\text{Co}(\text{NH}_3)_6^{++}$  (claims 5 and 18)
5.  $\text{Sn}^{+2}$  (claims 5 and 18)
6.  $\text{S}^{-2}$  (claims 5 and 18)
7.  $\text{Tl}^{+2}$  (claims 5 and 18)
8. Methyl viologen (claims 5 and 18)
9. Methylene blue (claims 5 and 18)
10. Thialene (claims 5 and 18)
11. Iodine (claims 5 and 18)
12. Dimethylferrocene (DMF) ferricinium (claims 5 and 18)
13. Ferrocene monocarboxylic acid ( $\text{FCOOH}$ ) (claims 5 and 18)
14. 7,7,8,8-Tetracyanoquinodimethane (TCNQ) (claims 5 and 18)
15. Tetrathiafulvalene (TTF) (claims 5 and 18)
16. Nickelocene (Nc) (claims 5 and 18)
17. N- Methylacridinium ( $\text{NMA}^+$ ) (claims 5 and 18)
18. tetrathiafulvalene (TTT) (claims 5 and 18)
19. N-methylphenazinium ( $\text{NMP}^+$ ) (claims 5 and 18)
20. Hydroquinone (claims 5 and 18)
21. Quinhydrone (claims 5 and 18)
22. 3,3',5,5'-Tetramethylbenzidine (TMB) (claims 5 and 18)
23. 3-Methyl-2- benzothiazolinone hydrazone hydrochloride and 3-dimethylaminobenzoic acid (MBTH- DMAB) (claims 5 and 18)
24. o-Dianisidine (claims 5 and 18)
25. o-Toluidine (claims 5 and 18)
26. Sulfonated 2,4-dichloro-phenol plus 4-amino phenazone (claims 5 and 18)
27. Benzidine (claims 5 and 18)
28. 3-Methyl-2-benzothiazolinone hydrazone plus 3-(dimethylamino) benzoic acid (claims 5 and 18)
29. 3-Methyl-2-benzothiazolinone hydrazone plus 2- methoxy-4 allyl phenol (claims 5 and 18)
30. 4- Aminoantipyrene-dimethylaniline and 4-aminoantipyrene -4-methoxynaphthol (claims 5 and 18)
31. Mixtures thereof (for this species, a further selection of specific mixture of above listed redox mediators is required, claims 5 and 18)

List III: Surfactant (claims 6 and 19)

1. Cholic acid (claims 6 and 19)
2. Triton X-100 (claims 6 and 19)

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3. Polyethylene glycol (claims 6 and 19)
4. Sodium lauryl sulfate (claims 6 and 19)
5. Sodium lauryl sarcosinate (claims 6 and 19)
6. Hydroxypropyl methylcellulose ("Methocel" 40-101 personal care grade) (claims 6 and 19)
7. Tetrapropylene diphenyloxide disulphonate sodium salt ("DOWFAX 2A 1") (claim claims 6 and 19)
8. Capryloamphocarboxypropionate ("MIRALOL J2M-SF") polyoxyethylene-2-cetyl ether (claims 6 and 19)
9. Surfynol 485 (claims 6 and 19)
10. MEGA-8 (claims 6 and 19)
11. MEGA-10 (claims 6 and 19)
12. Mixtures thereof (for this species, a further selection of specific mixture of above listed surfactants is required, claims 6 and 19)

List IV: Stabilizer (claims 7 and 20)

1. Gelatin (claims 7 and 20)
2. Bovine serum albumin (claims 7 and 20)
3. Glutamate (claims 7 and 20)
4. L-arginine (claims 7 and 20)
5. Gantrez (claims 7 and 20)
6. Mannitol (claims 7 and 20)
7. Gum Arabic (claims 7 and 20)
8. Low viscosity polypep (claims 7 and 20)
9. Methocel (claims 7 and 20)
10. mixtures thereof used separately or in combination (for this species, a further selection of specific mixture of above listed surfactants is required, claims 7 and 20)

List V: Buffer (claims 8 and 21)

1. Citrate salts succinate salts (claims 8 and 21)
2. Tris-(hydroxymethyl) aminomethane (claims 8 and 21)
3. Phosphate salts (claims 8 and 21)
4. 2(N-morpholino) ethanesulfonic acid (claims 8 and 21)
5. Mixtures thereof (for this species, a further selection of specific mixture of above listed buffers is required, claims 8 and 21)

List VI: Electrically Conductive Layers of the Sensing, Reference and Passive Cover Electrodes (claims 9 and 22)

1. Electrically conductive carbon (claims 9 and 22)
2. Electrically conductive graphite (claims 9 and 22)
3. Copper (claims 9 and 22)
4. Silver (claims 9 and 22)
5. Gold (claims 9 and 22)

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6. Platinum (claims 9 and 22)
7. Nickel (claims 9 and 22)
8. Stainless steel (claims 9 and 22)
9. Iron (claims 9 and 22)
10. Mixtures thereof (for this species, a further selection of specific mixture of above listed electrically conductive layers is required, claims 9 and 22)

List VII: Non-Conductive Support Member (claims 11, 12, 24, and 25)

1. Non-conductive film (claims 11 and 24)
2. Sheet forming polymeric material (claims 11, 12, 24, and 25)
  - a. Polyvinyl chloride (claims 11, 12, 24, and 25)
  - b. Polyester (claims 11, 12, 24, and 25)
  - c. Polycarbonate (claims 11, 12, 24, and 25)
  - d. Vinyl acetate copolymer (claims 11, 12, 24, and 25)
  - e. Nylon (claims 11, 12, 24, and 25)
  - f. Poly (1,4-butleneterephthalate) (claims 11, 12, 24, and 25)
  - g. Cellulose propionate (claims 11, 12, 24, and 25)
  - h. Ethylene/acrylic acid copolymer (claims 11, 12, 24, and 25)
  - i. Polybutadiene (claims 11, 12, 24, and 25)
  - j. Polyethylene (claims 11, 12, 24, and 25)
  - k. Polypropylene (claims 11, 12, 24, and 25)
  - l. Polyimide (claims 11, 12, 24, and 25)
  - m. Acrylic film (claims 11, 12, 24, and 25)
  - n. Polyurethane (claims 11, 12, 24, and 25)
  - o. Polystyrene (claims 11, 12, 24, and 25)
  - p. Polyvinyl fluoride (claims 11, 12, 24, and 25)
3. Ceramics (claims 11 and 24)
4. Glass (claims 11 and 24)
5. Paper (claims 11 and 24)
6. Cardboard (claims 11 and 24)

List VIII: Spacers (claims 13 and 26)

1. Adhesives (claims 13 and 26)
2. Double sided adhesive tape (claims 13 and 26)
3. Adhesive laminating tapes (claims 13 and 26)

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.



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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (indicated by numbers) and subspecies (indicated by lower case letters) if present from each of the eight lists of species set forth above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, 1-3, 10, 14-16, and 23 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the

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requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

### ***Election of Species within Group II***

6. This application contains claims directed to the following patentably distinct species:

#### **List I: Electrically Conductive Tracks (claims 30 and 43)**

1. Metallic silver (claims 30 and 43)
2. Silver salts (claims 30 and 43)
3. Mixtures of metallic silver and silver salts (claims 30 and 43)
4. Conductive graphite (claims 30 and 43)
5. Carbon (claims 30 and 43)
6. Copper (claims 30 and 43)
7. Platinum (claims 30 and 43)
8. Cobalt (claims 30 and 43)
9. Nickel (claims 30 and 43)
10. Gold (claims 30 and 43)
11. Electrically conductive polymers (claims 30 and 43)

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List II: Redox Mediator (claims 31 and 44)

1. Ferrocyanide salts ( $\text{Fe}(\text{CN})_6^{4-}$ ) (claims 31 and 44)
2. HCN (claims 31 and 44)
3.  $\text{I}^-$  (claims 31 and 44)
4.  $\text{Co}(\text{NH}_3)_6^{++}$  (claims 31 and 44)
5.  $\text{Sn}^{+2}$  (claims 31 and 44)
6.  $\text{S}^{-2}$  (claims 31 and 44)
7.  $\text{Tl}^{+2}$  (claims 31 and 44)
8. Methyl viologen (claims 31 and 44)
9. Methylene blue (claims 31 and 44)
10. Thialene (claims 31 and 44)
11. Iodine (claims 31 and 44)
12. Dimethylferrocene (DMF) ferricinium (claims 31 and 44)
13. Ferrocene monocarboxylic acid ( $\text{FCOOH}$ ) (claims 31 and 44)
14. 7,7,8,8-Tetracyanoquinodimethane (TCNQ) (claims 31 and 44)
15. Tetrathiafulvalene (TTF) (claims 31 and 44)
16. Nickelocene (Nc) (claims 31 and 44)
17. N- Methylacridinium ( $\text{NMA}^+$ ) (claims 31 and 44)
18. tetrathiafulvalene (TTT) (claims 31 and 44)
19. N-methylphenazinium ( $\text{NMP}^+$ ) (claims 31 and 44)
20. Hydroquinone (claims 31 and 44)
21. Quinhydrone (claims 31 and 44)
22. 3,3',5,5'-Tetramethylbenzidine (TMB) (claims 31 and 44)
23. 3-Methyl-2- benzothiazolinone hydrazone hydrochloride and 3-dimethylaminobenzoic acid (MBTH- DMAB) (claims 31 and 44)
24. o-Dianisidine (claims 31 and 44)
25. o-Toluidine (claims 31 and 44)
26. Sulfonated 2,4-dichloro-phenol plus 4-amino phenazone (claims 31 and 44)
27. Benzidine (claims 31 and 44)
28. 3-Methyl-2-benzothiazolinone hydrazone plus 3-(dimethylamino) benzoic acid (claims 31 and 44)
29. 3-Methyl-2-benzothiazolinone hydrazone plus 2- methoxy-4 allyl phenol (claims 31 and 44)
30. 4- Aminoantipyrene-dimethylaniline and 4-aminoantipyrene -4-methoxynaphthol (claims 31 and 44)
31. Mixtures thereof (for this species, a further selection of specific mixture of above listed redox mediators is required, claims 31 and 44)

List III: Surfactant (claims 32 and 45)

1. Cholic acid (claims 32 and 45)
2. Triton X-100 (claims 32 and 45)
3. Polyethylene glycol (claims 32 and 45)

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4. Sodium lauryl sulfate (claims 32 and 45)
5. Sodium lauryl sarcosinate (claims 32 and 45)
6. Hydroxypropyl methylcellulose ("Methocel" 40-101 personal care grade) (claims 32 and 45)
7. Tetrapropylene diphenyloxide disulphonate sodium salt ("DOWFAX 2A 1") (claim claims 32 and 45)
8. Capryloamphocarboxyropinoate ("MIRALOL J2M-SF") polyoxyethylene-2-cetyl ether (claims 32 and 45)
9. Surfynol 485 (claims 32 and 45)
10. MEGA-8 (claims 32 and 45)
11. MEGA-10 (claims 32 and 45)
12. Mixtures thereof (for this species, a further selection of specific mixture of above listed surfactants is required, claims 32 and 45)

List IV: Stabilizer (claims 33 and 46)

1. Gelatin (claims 33 and 46)
2. Bovine serum albumin (claims 33 and 46)
3. Glutamate (claims 33 and 46)
4. L-arginine (claims 33 and 46)
5. Gantrez (claims 33 and 46)
6. Mannitol (claims 33 and 46)
7. Gum Arabic (claims 33 and 46)
8. Low viscosity polypep (claims 33 and 46)
9. Methocel (claims 33 and 46)
10. mixtures thereof used separately or in combination (for this species, a further selection of specific mixture of above listed surfactants is required, claims 33 and 46)

List V: Buffer (claims 34 and 47)

1. Citrate salts succinate salts (claims 34 and 47)
2. Tris-(hydroxymethyl) aminomethane (claims 34 and 47)
3. Phosphate salts (claims 34 and 47)
4. 2(N-morpholino) ethanesulfonic acid (claims 34 and 47)
5. Mixtures thereof (for this species, a further selection of specific mixture of above listed buffers is required, claims 34 and 47)

List VI: Electrically Conductive Layers of the Sensing, Reference and Passive Cover Electrodes (claims 35 and 48)

11. Electrically conductive carbon (claims 35 and 48)
12. Electrically conductive graphite (claims 35 and 48)
13. Copper (claims 35 and 48)
14. Silver (claims 35 and 48)
15. Gold (claims 35 and 48)
16. Platinum (claims 35 and 48)

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17. Nickel (claims 35 and 48)
18. Stainless steel (claims 35 and 48)
19. Iron (claims 35 and 48)
20. Mixtures thereof (for this species, a further selection of specific mixture of above listed electrically conductive layers is required, claims 35 and 48)

List VII: Non-Conductive Support Member (claims 37, 38, 50, and 51)

1. Non-conductive film (claims 37 and 50)
2. Sheet forming polymeric material (claims 37, 38, 50, and 51)
  - a. Polyvinyl chloride (claims 37, 38, 50, and 51)
  - b. Polyester (claims 37, 38, 50, and 51)
  - c. Polycarbonate (claims 37, 38, 50, and 51)
  - d. Vinyl acetate copolymer (claims 37, 38, 50, and 51)
  - e. Nylon (claims 37, 38, 50, and 51)
  - f. Poly (1,4-butleneterephthalate) (claims 37, 38, 50, and 51)
  - g. Cellulose propionate (claims 37, 38, 50, and 51)
  - h. Ethylene/acrylic acid copolymer (claims 37, 38, 50, and 51)
  - i. Polybutadiene (claims 37, 38, 50, and 51)
  - j. Polyethylene (claims 37, 38, 50, and 51)
  - k. Polypropylene (claims 37, 38, 50, and 51)
  - l. Polyimide (claims 37, 38, 50, and 51)
  - m. Acrylic film (claims 37, 38, 50, and 51)
  - n. Polyurethane (claims 37, 38, 50, and 51)
  - o. Polystyrene (claims 37, 38, 50, and 51)
  - p. Polyvinyl fluoride (claims 37, 38, 50, and 51)
3. Ceramics (claims 37 and 50)
4. Glass (claims 37 and 50)
5. Paper (claims 37 and 50)
6. Cardboard (claims 37 and 50)

List VIII: Spacers (claims 39 and 52)

1. Adhesives (claims 39 and 52)
2. Double sided adhesive tape (claims 39 and 52)
3. Adhesive laminating tapes (claims 39 and 52)

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (indicated by numbers) and subspecies (indicated by lower case letters) if present from

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each of the eight lists of species set forth above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, 127-29, 36, 40-42, and 49 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are

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added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

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All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to UNSU JUNG whose telephone number is (571)272-8506. The examiner can normally be reached on M-F: 9-5.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya can be reached on 571-272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Unsu Jung/  
Unsu Jung  
Primary Examiner  
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